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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,577	01/25/2000	John R. Carlson	044574-5061-US	8713

9629 7590 09/05/2002

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EXAMINER

MURPHY, JOSEPH F

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/05/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/491,577

Applicant(s)

CARLSON ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 11 July 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): The rejection under 35 USC 101.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

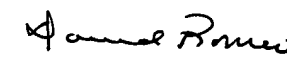
Claim(s) allowed: 36.

Claim(s) objected to: _____.

Claim(s) rejected: 27-35 and 43-45.Claim(s) withdrawn from consideration: 11-26 and 37-42.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____




DAVID S. ROMEO
PRIMARY EXAMINER

Continuation of 5: The amendment does NOT place the application in condition for allowance because:

Claims 27-35, 43-45 stand rejected under 35 USC 11, first paragraph because one skilled in the art would not know how to use the claimed invention. The Specification as filed does not provide the nexus between the nucleic acid of SEQ ID NO: 31 and odorant receptor activity. It is unclear what function is encompassed by the term "odorant receptor activity". Furthermore, there is insufficient guidance provided in the specification as to which are the critical residues of the amino acid sequence that are necessary to maintain functionality of the encoded protein, therefore, one skilled in the art clearly would not know how to use the claimed invention.

The rejection of claims 27-35, 45 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid molecule encoding the polypeptide encoded by SEQ ID NO: 31, does not reasonably provide enablement for a nucleic acid molecule that encodes a fragment of the polypeptide encoded by SEQ ID NO: 31. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. It is unclear what function is encompassed by the term "odorant receptor activity" since for a polypeptide to function as an odorant receptor it must bind the odorant molecule and bind and activate the associated G proteins. Furthermore, there is insufficient guidance provided in the specification as to which are the critical residues of the amino acid sequence that are necessary to maintain functionality of the encoded protein.

Claims 43-44 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The addition of the functional limitation has not described the genus the claim is drawn to, because it is unclear what function is encompassed by the term "odorant receptor activity". The Specification does not describe which residues are necessary for the genus of nucleic acids to encode, in order for the encoded polypeptides to retain the function "odorant receptor activity". Structural features that could distinguish compounds in the genus from others in the protein class are missing from the disclosure. No common structural attributes identify the members of the genus. The general knowledge and level of skill in the art do not supplement the omitted description because specific, not general, guidance is what is needed. Since the disclosure fails to describe the common attributes or characteristics that identify members of the genus, and because the genus is highly variant, SEQ ID NO: 31 alone is insufficient to describe the genus.

The rejection under 35 USC 102(a) is maintained because Celniker teaches a nucleic acid which would hybridize under the indicated conditions, and the addition of the functional limitation has not distinguished the genus the claim is drawn to since for a polypeptide to function as an odorant receptor.